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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,306	11/14/2003	Steffen Dittmer	DITTMER-3	2124

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EXAMINER
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LORENCE, RICHARD M

ART UNIT	PAPER NUMBER
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3681

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/714,306

Applicant(s)

DITTMER ET AL.

Examiner

Richard M. Lorence

Art Unit

3681

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/14/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This is the first Office action on the merits of Application No. 10/714,306 filed on November 14, 2003. Claims 1-20 are currently pending.

#### ***Priority***

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Germany on May 18, 2001. It is noted, however, that applicant has not filed a certified copy of the German application as required by 35 U.S.C. 119(b).

#### ***Drawings***

The replacement drawing sheets (Figures 2 and 3) were received on December 2, 2003. These drawings are acceptable.

The drawings are objected to because of the following informalities:

In Figure 1 "13" should be - - 13a - -.

Also in Figure 1 the cross-hatching of the lobes 23 in the vicinity of the recesses 24 should indicate thermoplastic material the same as the remainder of the sliding element 19a.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Specification***

The disclosure is objected to because of the following informalities:

In line 6 of paragraph [0009] and elsewhere throughout the description "calotte-shaped" is somewhat vague. It is believed that "partial sphere" or similar geometric description would better describe the curved annular surface.

In line 3 of paragraph [0022] "1" should read - - 1a - -.

In line 10 of paragraph [0023] "18" should read - - 18a - -.

In line 13 of paragraph [0023] "13" should read - - 13a - -.

Appropriate correction is required.

### ***Claim Objections***

Claim 1 objected to because of the following informalities: In line 8 of claim 1 "calotte-shaped" is somewhat vague. It is believed that "partial sphere" or similar geometric description would better describe the curved annular surface. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 3681

Claims 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Newton '933.

No patentable weight is given to the statement of intended use in the claim preamble. The '933 patent to Newton discusses at column 3, lines 13-39 a bearing (sliding element) formed of carbon fiber embedded polyaryletherketone with PTFE added.

Claims 18-20 are further rejected under 35 U.S.C. 102(b) as being anticipated by Johnson '204.

No patentable weight is given to the statement of intended use in the claim preamble. The '933 patent to Johnson discusses at column 1, lines 47-62 a thrust washer (sliding element) formed of polyaryletherketone or polyamide. Note also column 4, lines 56-65 which disclose the carbon fiber filler, and column 5, lines 5-16 which further disclose the addition of PTFE.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brandenstein '361 in view of Dittmer '909 (DE).

The '361 patent to Brandenstein shows a self-adjusting release bearing including the first and second rings 1, 2, rolling elements 4 and the adjustment ring 15 having a calotte shaped section of radius R supported on a complimentary section of the ring 2. Brandenstein does not show the sliding element of thermoplastic material in the contact zone. The '909 German patent document suggests that the adjustment ring 15a should be formed of thermoplastic material in the contact zone. It would have been obvious to one having ordinary skill in the art at the time the invention was made to interpose thermoplastic material in the contact zone of Brandenstein's release bearing in view of the suggestion of Dittmer that plastic material facilitates the sliding of the adjustment ring relative to the bearing race. The selection of a suitable thermoplastic as well as the appropriate thickness thereof and manner of attachment would have been obvious to the ordinarily skilled artisan.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Art Unit: 3681

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 6,684,997 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application are merely broader recitation of the claims in the '997 patent which also define the release bearing including the inner and outer rings, rolling elements, adjustment ring and thermoplastic element.

Claims 1-20 are also provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of copending Application No. 10/103,909. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application are merely broader recitation of the claims in the '909 application which also define the release bearing including the inner and outer rings, rolling elements, adjustment ring and thermoplastic element.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Prior Art Citation***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Each of the prior art documents cited by applicant in the IDS filed in November 14, 2003 have been considered. Note the attached form PTO-1449. The examiner further cites Ladin '440, Mori et al. '492, Harrington '867 and Winklemann et al. '996 each of which show self adjusting clutch release bearing assemblies.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard M. Lorence whose telephone number is (703) 308-3062. The examiner can normally be reached on Mondays through Fridays from 9:00AM to 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles A. Marmor can be reached on (703) 308-0830. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



Art Unit: 3681

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Richard M. Lorence  
Primary Examiner  
Art Unit 3681

Lorence/rml